



PATENT
ATTORNEY DOCKET NO. 046103-5011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application of:)
Hiroki TAKEUCHI et al.) Confirmation No.: 7305
Application No.: 10/026,938) Group Art Unit No.: 1712
Filed: December 27, 2001) Examiner: R. Sellers
For: EMBEDDING RESIN)

Mail Stop Amendment

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22314

Sir:

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

In a Restriction Requirement under 35 U.S.C. § 121 dated March 21, 2005 (Paper No. 305), the period for reply to which has been extended to May 21, 2005, by a petition for a one-month extension of time filed concurrently herewith, Applicants provide the following responses.

Applicants hereby elect Specie I, drawn to a coloring agent of claim 4 such as the carbon black defined in claims 15-18, with traverse. Applicants respectfully traverse the election of species requirement for the following reasons. The Office Action dated March 21, 2005, identifies four species and asserts that the species are “patently distinct” without providing any basis or rationale for coming to the conclusion that the species are “patently distinct. MPEP § 803 instructs that “Examiners must provide

reasons and/or examples to support conclusions.” Similarly, MPEP § 808 instructs that

04/28/2005 SZEWDIE1 00000109 500310 10026938

01 FC:1251

120.00 DA

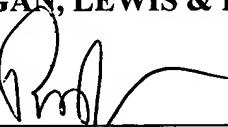
1-WA/2381421.1

“[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.” In addition, the Office Action asserts that claims 1, 3, 4, 6-11, and 15-18 in the alleged Species I-IV are all generic claims. MPEP § 809.02(d) instructs that “[w]here only generic claims are presented, no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary.” Applicants respectfully assert that none of the generic claims 1, 3, 4, 6-11, and 15-18 in the present application is alleged to recite a multiplicity of species that necessitates an unduly extensive and burdensome search by the Office. Accordingly, since the Office Action provides a mere statement of conclusion without a basis or rationale (i.e., reasons and/or examples), and there are no separately claimed and distinct Species in the present application, Applicants respectfully assert that the election requirement improper. Thus, Applicants respectfully request that the election requirement be withdrawn and all of claims 1, 3, 4, 6-11, and 15-18 be examined

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: April 27, 2005
By: 

Robert. J. Goodell
Reg. No. 41,040

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202.739.3000
Fax: 202.739.3001